IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Stephen Fife Sheldon**	§ §	Group Art Unit: **2168**
Serial No.: **10/800,493**	§ §	
	§	Examiner: **Sanders, Aaron J.**
Filing Date: **March 15, 2004**	§ §	
Title: **Simple Expression Modification**	§	Attorney. Docket No.: **11466**
in a SQL Query	§	

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DATE OF SUBMISSION: AUGUST 28, 2008
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

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Reasons for Review

Claims 1, 7-15, 21-29, and 35-42 are pending. A Final Office Action issued on April 28, 2008. The Applicant responded on July 28, 2008. An Advisory Action issued on August 8, 2008.

I. Applicant's July 28, 2008 amendments should have been entered.

The Final Office Action objected to claims 1 and 15 because of typographical errors. Final Office Action at 3. Applicant amended claims 1 and 15 as suggested in the Office Action to correct the typographical errors. The Advisory Action indicated that the amendments would not be entered because the "amendment to at least claim 15 raises new issues that would require further search and consideration." The Advisory Action continued that "the limitation 'perform query optimization on the expression' changes the scope from the previously claimed 'perform expression optimization on one or more of the expressions.'" Advisory Action at 2. Applicant respectfully disagrees and requests that the amendments be entered.

II. Claims 1, 15, and 29 are enabled at least by what would be known to one of ordinary skill in the art.

The Final Office Action rejected claims 1, 15, and 29 under 35 USC 112, first paragraph, as failing to comply with the enablement requirement, arguing that "the limitations 'performing further query optimization to produce a result' and 'saving the result in a memory' do not appear in the specification." Final Office Action at 3 (emphasis in original).

With respect to the "performing further query optimization to produce a result" limitation, Applicant responded that one example of a "result" is shown in Fig. 3 as the output of element 325 ("executable steps"). July 28, 2008 Response at 8. The Advisory Action disagreed, arguing that "this is not clear because it is not clear that the 'optimization' in para. 20 corresponds to the 'further query optimization.'" Advisory Action at 2.

The fact that "further query optimization" corresponds to the "optimization" in paragraph [0020] is illustrated by referring to the patent application as originally filed. Claim 10 states that "further query optimization" includes "determining a transitive closure of the database query." In paragraph [0020] lines 24-25, the specification states that "the optimizer (block 325) determines the transitive closure of the SQL query." Thus, for at least this reason, "further query optimization" corresponds to the "optimization" in paragraph [0020].

With respect to the "saving the result in a memory" limitation, Applicant responded that this limitation was enabled because a person of ordinary skill would understand that the "executable steps" may be saved in a memory so that they can be acted on by the dispatcher, element 210 shown in Fig. 2. July 28, 2008 Response at 8. The Advisory Action disagreed arguing that "[j]ust because 'a person of ordinary skill would understand that the "executable steps" may be saved in a memory' . . . does not make the limitation part of the Applicant's invention." Advisory Action at 2.

The Advisory Action's argument is contrary to Federal Circuit law, which states that the scope of enablement is not limited to what is disclosed in the specification; it also includes "what would be known to one of ordinary skill in the art without undue experimentation. *Abbott Labs v. Andrx Pharmaceuticals, Inc.*, 452 F.3d 1331, 1341 (Fed. Cir. 2006), *citing Invitrogen Corp. v. Clontech Labs., Inc.*, 429 F.3d 1052, 1070-71 (Fed. Cir. 2005). The Advisory Action does not argue with Applicant's contention that a person of ordinary skill would understand that the "executable steps" may be saved in a memory so that they can be acted on by the dispatcher, element 210 shown in Fig. 2. For at least this reason, this element of claim 1 is enabled.

Applicant respectfully requests that this rejection be withdrawn.

III.   The pending claims are patentable subject matter under 35 USC 101.

The Final Office Action rejected all pending claims under 35 USC 101 arguing that the claimed invention is directed to non-statutory subject matter because the disclosed subject matter fails to produce a tangible result. Final Office Action at 4. This rejection appears to arise from the previous rejection, i.e., that the "produce a result" element is not enabled. The enablement rejection should be withdrawn, as shown above. Accordingly, this rejection under 35 USC 101 should be withdrawn as well.

The Final Office Action made further arguments regarding the rejection under 35 USC 101, which appear to duplicate arguments made earlier in the Final Office Action. Office Action at 23.

IV.   Claims 1, 7-9, 11-13, 15, 21-23, 25-27, 29, 35-37, and 39-41 are not obvious over Paulley in view of Warner because "propagating" is not the same as "removing and inserting"

The Final Office Action rejected claims 1, 7-9, 11-13, 15, 21-23, 25-27, 29, 35-37, and 39-41 under 35 USC 103(a) as being unpatentable over United States Patent No. 6,665,664 ("hereinafter Paulley") in view of United States Patent Publication No. 2005/0055338 (hereinafter "Warner"). Final Office Action at 5.

In its July 28, 2008 Response, Applicant disagreed. The Final Office Action's combination of Paulley and Warner does not teach or suggest determining that the second child node represents the constant 0 and that the parent node represents an arithmetic operation selected from the group consisting of addition and subtraction; and in response, removing the parent node and its children from the tree structure and inserting the first child node in its place, as required by independent claims 1, 15, and 29. The Final Office Action admits that Paulley does not teach this element. Final Office Action at 7. Warner does not teach it either. Even assuming the value of one of the nodes 108 or 110 in Warner's Fig. 1 is "0," Warner does not teach "removing the parent node and its children from the tree structure and inserting the first child node in its place," as required by independent claims 1, 15, and 29. Warner teaches "propagating" the result of the evaluation of the operator at 104 up the tree. "Propagating" is not the same as "removing . . . and inserting." In particular, Warner does not teach removing nodes 104, 108, and 110 and inserting one of the child nodes (108 or 110) in its place.

The Advisory Action admitted that "Warner and Paulley may not explicitly teach 'that the second child node represents the constant 0,'" but argued that "it is obvious that the referenced 'B' could have the value '0,'" and that in that situation, "the value 'A' at 108 would replace the value '+' at 104, see Warner para. 6." The Advisory Action argued that "[a]n example of this process is depicted in Fig. 3C." Advisory Action at 2. The Advisory Action's argument is not materially different from that made in the Final Office Action and does not meet the substance of Applicant's argument. The cited material from Warner describes propagating, not removing and inserting, as required by the rejected claims.

For at least this reason, the Office Action's combination of Paulley and Warner does not render claims 1, 15, and 29 obvious. Claims 7-9, 11-13, 21-23, 25-27, 35-37, and 39-41 depend from one of claims 1, 15, and 29 and are patentable for at least the same reason. Applicant respectfully requests that this rejection be withdrawn.

V. Claims 10, 14, 24, 28, 38, and 42 are not obvious over Paulley in view of Nuutila for the same reason.

The Final Office Action rejected claims 10, 14, 24, 28, 38, and 42 under 35 USC 103(a) as being unpatentable over Paulley in view of Esko Nuutila, "Transitive Closure," Helsinki University of Technology, (October 9, 1995)(hereinafter "Nuutila"). Final Office Action at 18.

Claims 10, 14, 24, 28, 38, and 42 depend from one of claims 1, 15, and 29. The Office Action admits that Paulley is missing several elements from claims 1, 15, and 29, *see* Office Action at 6-8, 10-12, and 15-17, and does not suggest that Nuutila provides the missing elements. In its July 28, 2008 Response, Applicant noted its assumption that the Office Action intended to reject claims 10, 14, 24, 28, 38, and 42 under 35 USC 103(a) as being unpatentable over Paulley in view of Warner and further in view of Nuutila. The Advisory Action did not correct the assumption.

Applicant respectfully disagrees. As described above, the Office Action's combination of Paulley and Warner does not teach at least one element of claims 1, 15, and 29. The Office Action does not argue that Nuutila provides the missing element. Accordingly, claims 10, 14, 24, 28, 38, and 42 are patentable for at least the reasons described above for claims 1, 15, and 29.

VI. The drawings are sufficient

The Final Office Action argued that the drawings do not show the method of the independent claims. The Final Office Action argued that "[r]eferenced Fig. 1 does not show a method, and does not contain elements 320 and 325." Final Office Action at 22. In its July 28, 2008 Response, Applicant disagreed, arguing that:

- Fig. 1 shows the Parsing Engine 130, which is shown in greater detail in Fig. 2;
- Fig. 2 shows a Parser 205, which is shown in greater detail in Fig. 3; and
- Fig. 3 includes elements 320 and 325.

The Advisory Action did not answer this argument. Presumably, the objection to the drawings has been withdrawn.

The Final Office Action further argued that "it is unclear which steps of Figs. 5-6 and 11A-12 correspond to at least the claim limitations 'performing expression optimization,' 'performing further query optimization,' 'saving the result,' 'representing the query as a tree structure,' and 'representing the expression . . . as a parent node having . . . child node[s].'" Final Office Action at 22. In its July 28, 2008 Response, Applicant responded that "flow charts or source code listings are not a requirement for adequately disclosing the functions of software." *Fonar Corp. v. General Electric Co.*, 107 F.3d 1543, 1549 (Fed. Cir. 1997) (best mode context); MPEP 2163(I)(A). Embodiments of claim limitations "performing expression optimization" and "performing further query optimization" are shown in Fig. 3, elements 320 and 325 and in Figs. 5-13. An embodiment of the element "saving the result" is shown as the output of element 325, as discussed above. Embodiments of the elements "representing the query as a tree structure" and "representing the expression in the tree structure as a parent node having a first child node and a second child node" are shown in Figs. 4A and 4B.

The Advisory Action did not respond to this argument. Presumably, this objection has been withdrawn.